

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SHIGEKI UMEZAWA  
and  
TOSHIAKI WAKISAKA

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Appeal No. 95-4588  
Application 08/127,123<sup>1</sup>

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ON BRIEF

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<sup>1</sup> Application for patent filed September 27, 1993. According to appellants, the application is a continuation of Application 07/689,675, filed April 23, 1991, abandoned; which is a continuation of Application 07/399,040, filed August 28, 1989, abandoned.

Appeal No. 95-4588  
Application 08/127,123

Before MEISTER, FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 through 5, 8 through 10, 12 through 14 and 16, which are all of the claims remaining in this application. Claims 1, 2, 6, 7, 11 and 15 have been canceled.<sup>2</sup>

As noted on page 1 of the specification, appellants' invention relates to a brake band used for providing a braking force to a speed change gear of an automobile, an agricultural machine, etc. Of particular importance is that the lining (1 in Figures 1 and 2(b)) of the brake band be made of wet

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<sup>2</sup> Minor amendments to claims 9, 10 and 16 were requested in a paper filed November 10, 1994 subsequent to the final rejection. As noted in the advisory action mailed November 22, 1994 (Paper No. 39), entry of this amendment has overcome the rejection under 35 U.S.C. § 112, second paragraph, that was included in the final rejection (Paper No. 37).

Appeal No. 95-4588  
Application 08/127,123

frictional material containing lubricating oil and also include an oil-containing cavity (30) formed in the lining itself

so that the oil contained in the lining itself and the oil held in the cavity 30 both flow as indicated by arrows S, thereby dispersing the frictional heat. Therefore, in this case, a higher cooling effect can be achieved than in the conventional brake band (specification, page 5).

Independent claim 10, one of two independent claims on appeal, is representative of the claimed subject matter and a copy of that claim, as it appears in the Appendix to appellants' brief, is attached to this decision.

The references of record relied upon by the examiner in a rejection of the appealed claims under 35 U.S.C. § 103 are:

Smith 1923	1,464,142	Aug. 7,
Bousquet 1924	1,510,825	Oct. 7,
Rogers et al. (Rogers) 1967	3,347,345	Oct. 17,

Appeal No. 95-4588  
Application 08/127,123

Claims 3 through 5, 8 through 10, 12 through 14 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bousquet in view of Smith and Rogers.<sup>3</sup>

Rather than reiterate the examiner's explanation of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding that rejection, we make

reference to the examiner's answer (Paper No. 43, mailed May 10, 1995) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 42, filed February 3, 1995) for appellants' arguments thereagainst.

#### OPINION

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<sup>3</sup> While the statement of the rejection on page 3 of the examiner's answer (Paper No. 43) includes claims 6 and 7, it is clear from the record of this application that these claims were canceled in the amendment filed April 28, 1994 (Paper No. 36).

Appeal No. 95-4588  
Application 08/127,123

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of this review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 cannot be sustained. However, pursuant to 37 CFR § 1.196(b), we have also entered a new ground of rejection, infra, under 35 U.S.C. § 112, first paragraph, against the appealed claims. Our reasons follow.

The proper test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Elec. Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089,

1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The law followed by our court of

Appeal No. 95-4588  
Application 08/127,123

review, and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976).

Essentially for the reasons stated by appellants in their brief (pages 4-9), we find that the examiner's rejection under 35 U.S.C. § 103 is in error. Like appellants, we find nothing in the references applied by the examiner which teaches or suggests appellants' claimed brake band and lining wherein the cavities formed in the lining on the side of the bonding surface thereof are "sealed from an external oil source during operation," as required in both independent claims 10 and 16 on appeal. The examiner's attempt to use the teaching at column 3, lines 21-34, of Rogers for supplying this deficiency is unavailing, because Rogers has nothing to do with a cavity formed in a lining and located in the manner set forth in appellants' claims on appeal.

Appeal No. 95-4588  
Application 08/127,123

Based on the foregoing, the decision of the examiner rejecting claims 3 through 5, 8 through 10, 12 through 14 and 16 under 35 U.S.C. § 103 is reversed.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against the appealed claims:

Claims 3 through 5, 8 through 10, 12 through 14 and 16 are rejected under 35 U.S.C. § 112, first paragraph, as being drawn to subject matter that does not find support in the originally filed disclosure, i.e., as lacking a written description.

In particular, we note that the requirement in each of independent claims 10 and 16 that the cavities recited in the claims be "sealed from an external oil source during operation" finds no support in the originally filed disclosure. This limitation was first added to the claims in the amendment filed December 28, 1992 (Paper No. 26). As is

Appeal No. 95-4588  
Application 08/127,123

apparent from the original description in the specification as filed, the material of the brake band lining (1) is permeable to the oil used there-in and as such cannot provide cavities of the type claimed which are "sealed." Appellants' own description of the invention on

pages 2-3 of their brief would seem to support this understanding of the invention. On page 3 of the brief it is noted that the lining (1) "is permeable and thus the lubricating oil can flow into and out of lining 1 as required for cooling" (emphasis added).

In summary, as noted above, the decision of the examiner rejecting appealed claims 3 through 5, 8 through 10, 12 through 14 and 16 under 35 U.S.C. § 103 is reversed. In addition, a new ground of rejection of claims 3 through 5, 8 through 10, 12 through 14 and 16 under 35 U.S.C. § 112, first paragraph, has been added pursuant to 37 CFR § 1.196(b).



Appeal No. 95-4588  
Application 08/127,123

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

JAMES M. MEISTER )

Appeal No. 95-4588  
Application 08/127,123

	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT			
	CHARLES E. FRANKFORT	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	
		)	
	JEFFREY V. NASE	)	
	Administrative Patent Judge	)	

Appeal No. 95-4588  
Application 08/127,123

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Appeal No. 95-4588  
Application 08/127,123

APPENDED CLAIM

10. A lining for a brake band which comprises a curved thin strap having an adhesive thereon, brackets of different shapes being connected respectively to opposite ends of said strap, and a thin wet lining being bonded, at a bonding surface thereof, to an inner side of said curved strap, wherein cavities for containing lubricating oil are formed in said lining at a side of said bonding surface and wherein one portion of each of said cavities is closed by said curved strap and remaining portions of each of said cavities are surrounded by said lining so that said lubricating oil is contained within said cavities, said cavities being sealed from an external oil source during operation.